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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,437	08/01/2003	Laurent Mollicone	MS1-1556US	2858

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EXAMINER	
RUTLEDGE, AMELIA L	
ART UNIT	**PAPER NUMBER**
2176	
MAIL DATE	**DELIVERY MODE**
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/632,437	MOLLICONE ET AL.	
	Examiner	Art Unit	
	Amelia Rutledge	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 March 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11 and 13-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11 and 13-26* is/are rejected.

7)☐ Claim(s) *12* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 August 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *See Continuation Sheet*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date : 7/27/06; 8/31/06; 10/27/06;11/30/06; 1/8/07; 6/8/07.

DETAILED ACTION

1. This action is responsive to communications: Supplemental Appeal Brief, filed 03/30/2007; Amendment After Final, filed 08/01/2006; Information Disclosure Statements, filed 7/27/06; 8/31/06; 10/27/06; 11/30/06; 1/8/07; 6/8/07.

2. Claims 1-26 are pending. Claims 1, 20, and 24-26 are independent claims.

3. In view of the Appeal Brief filed on 03/30/2007, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

4. Applicant's Amendment After Final, filed 08/21/2006 has been entered.

Claim Objections

5. Claims 9 and 10 are objected to because of the following informalities: The claims appear to contain a typographical error for example claim 9 recites "each editing controls", it appears that the claim should read "each of the editing controls". Appropriate correction is required.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 20-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding independent claim 20, claim 20 is non-statutory because although the claim limitations cite methods and data structures, claim 20 represents an abstract idea and does not claim a practical application, or otherwise produce a useful, concrete, and tangible result. Specifically, claim 20 recites ...*determining whether a particular version of the processing functionality has been created that warrants generation of the upgrade module; and*

generating the upgrade module if the creation of the particular version warrants the generation of the upgrade module.

Therefore, in the method steps as recited in claim 20, if it is determined that generating the upgrade module is not warranted, the claim would not produce a useful, concrete, and tangible result.

In regard to dependent claims 21-23, claims 21-23 are rejected because they add nothing to render the claimed invention statutory.

In regard to independent claim 24, claim 24 is non-statutory because for being claimed as descriptive material *per se*, and is at best directed toward software *per se*. *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759. Claim 24 is nonstatutory because the invention is not recorded on a computer readable medium and therefore is not capable of causing functional change in the computer.

Regarding independent claim 25, claim 25 is directed to the apparatus used to implement the methods as claimed in independent claim 20, and is rejected along the same rationale. Further claim 25 recites descriptive material *per se*, and is at best directed toward software *per se*. *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759. Claim 25 is nonstatutory because the invention is not recorded on a computer readable medium and therefore is not capable of causing functional change in the computer.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. **Claims 1-10 and 14-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al. (hereinafter "Wang"), U.S. Pub No. 2002/0035579 A1, published March 2002, and further in view of Santos, U.S. Patent No. 7,107,521 B2, issued September 2006.**

Regarding independent claim 1, Wang teaches a method for upgrading documents for processing by processing functionality, comprising inputting a structured document having particular editing controls associated therewith into a particular version of the processing functionality; since Wang teaches a set of content materials, and a graphical web page editor to generate transform rules for display of content on specific devices (par. 0008-0017). Each item of web page content is modified for display on separate devices based on device capability. Wang teaches determining whether each of the particular page elements matches a set of expected page elements associated with the particular version of the processing functionality; and modifying the particular elements of the input structured document so that the particular elements match the set of expected page elements to thereby provide a modified structured document (par. 0054-0060). Wang teaches a web page editor that generates XSLT transform rules, assigns IDs to each web page element, matches the rules to the page elements, and modifies the page elements, using XSLT templates, so that the modified web page elements match the set of expected elements in the template (par. 0057-0076).

While Wang teaches modifying and matching page elements based on version of processing functionality, Wang strongly suggests but does not explicitly teach *editing*

controls associated therewith into a particular version of the processing functionality because Wang teaches a web page editor that generates XSLT transform rules, to modify page elements, but Wang does not specify that the page elements are editing controls. However, Santos teaches a system for dynamically generating rules for XML transformations, as well as customized rules, and Santos teaches inputting a structured document having particular editing controls associated therewith into a particular version of the processing functionality, since Santos teaches generating XSL rules to transform and modify editing controls of an input document (col. 2, l. 21-50; Fig. 4, 5, 6).

Both Wang and Santos are analogous art since both are directed toward modifying a structured document using XML, rules, and XSLT transformations. It would have been obvious to one of ordinary skill in the art at the time of the invention to have applied the method of overriding XSL rules disclosed by Santos to the graphical web page editor and XSLT files disclosed by Wang, because both Wang and Santos disclose interfaces to allow a user to easily manipulate XSLT rules, and the method of overriding default rules with dynamically generated rules disclosed by Santos would have ensured that the list of XSLT rules would remain updated with the most recent rules specified by the user.

Regarding dependent claim 2, Wang teaches transforming the modified structured document into another document suitable for presentation;
displaying the other document suitable for presentation using the processing functionality to provide a displayed document; and editing the displayed document (par.

0069-0072), since Wang teaches that pages can be modified and then further customized using the editor.

Regarding dependent claims 3 and 4, Wang teaches that the input structured document is expressed in a markup language that uses tags pertaining to subject matter fields in the input structured document, and wherein the input structured document is expressed in the extensible markup language (XML) (par. 0050 and 0059).

Regarding dependent claims 5 and 6, Wang teaches that the other document suitable for presentation is expressed in a markup language that uses tags pertaining to visual features associated with the presentation of the other document, and wherein the other document suitable for presentation is expressed in the hypertext markup language (HTML) (par. 0050 and 0059).

Regarding dependent claim 7, Wang teaches that the modifying uses an upgrade module that provides a transformation function using extensible stylesheet language (XSL) (par. 0050 and 0059).

Regarding dependent claim 8, which depends from claim 2, Wang teaches that the other document suitable for presentation comprises an electronic form having at least one user data entry field therein (Figs. 3 and 16a).

Regarding dependent claim 9, Wang teaches that the determining of whether each of the particular editing controls matches a set of expected editing controls associated with the particular version of the processing functionality comprises: determining whether the input structured document contains each editing controls expected by the particular version of the processing functionality, Wang teaches a set of

content materials, and a graphical web page editor to generate transform rules for display of content on specific devices (par. 0008-0017).

Regarding dependent claim 10, Wang teaches that the modifying of the particular editing controls of the input structured document to produce the modified structured document comprises creating each editing controls expected by the particular version of the processing functionality to provide created editing controls (par. 0047, 0048, 0051);

copying editing controls content from the input structured document into corresponding created editing controls in the modified structured document for those editing controls in the input structured document that have counterpart editing controls expected by the particular version of the processing functionality (par. 0047, 0048, 0051); and

creating default editing controls content in corresponding editing controls in the modified structured document for those created editing Controls that do not have counterpart editing controls in the input structured document (par. 0079-0083).

Wang teaches a web page editor that generates XSLT transform rules, assigns IDs to each web page element, including editing controls, matches the rules to the page elements, and modifies the page elements including the editing controls, using XSLT templates, so that the modified web page controls match the set of expected editing controls in the template (par. 0057-0076; claims 22-26).

Regarding dependent claim 11, Wang does not explicitly teach that the step of determining of whether each of the particular editing controls matches a set of expected

editing controls associated with the particular version of the processing functionality comprises: determining whether the input structured document lacks editing controls that were previously classified as optional but are no longer classified as optional in the particular version of the processing functionality.

However, Santos teaches determining whether the input structured document lacks editing controls that were previously classified as optional but are no longer classified as optional in the particular version of the processing functionality because Santos teaches a method of modifying document editing controls using XML, where assigning dynamically generated rules added to the containing XSL file have a higher priority than imported default XSL rules, and where the XSLT processor overrides the imported rules with the dynamically generated ones and processes the modified XML/XSL DOM to generate XML FO (col. 3, l. 1-31; col. 1, l. 43-60).

Both Wang and Santos are analogous art since both are directed toward modifying a structured document using XML, rules, and XSLT transformations. It would have been obvious to one of ordinary skill in the art at the time of the invention to have applied the method of overriding XSL rules disclosed by Santos to the graphical web page editor and XSLT files disclosed by Wang, because both Wang and Santos disclose interfaces to allow a user to easily manipulate XSLT rules, and the method of overriding default rules with dynamically generated rules disclosed by Santos would have ensured that the list of XSLT rules would remain updated with the most recent rules specified by the user.

Regarding dependent claim 13, while Wang does not explicitly teach that the expected editing controls are specified by a schema associated with the particular version of the processing functionality, Santos teaches the use of an XML schema (col. 2, l. 21-38).

Both Wang and Santos are analogous art since both are directed toward modifying a structured document using XML, rules, and XSLT transformations. It would have been obvious to one of ordinary skill in the art at the time of the invention to have applied the method of overriding XSL rules disclosed by Santos to the graphical web page editor and XSLT files disclosed by Wang, because both Wang and Santos disclose interfaces to allow a user to easily manipulate XSLT rules, and the method of overriding default rules with dynamically generated rules disclosed by Santos would have ensured that the list of XSLT rules would remain updated with the most recent rules specified by the user.

Regarding dependent claim 14, Wang teaches that the expected editing controls are specified by some information other than a schema associated with the particular version of the processing functionality, since Wang teaches that the expected editing controls are specified in an XSL file and transform rule database (par. 0056-0060).

Regarding dependent claim 15, Wang teaches that the input structured document corresponds to a markup language document generated by an earlier version of the processing functionality compared to the particular version (par. 0069-0072),

since Wang teaches that pages can be edited, modified, stored, and then further customized using the editor.

Regarding dependent claim 16, Wang teaches that the input structured document corresponds to a markup language document generated by a later version of the processing functionality compared to the particular version (par. 0069-0072), since Wang teaches that pages can be edited, modified, stored, and then further customized using the editor.

Regarding dependent claim 17, Wang teaches that the modifying is performed using an upgrade module, and wherein the upgrade module is developed without knowledge of any requirements of any input structured document, because Wang teaches importing template files from other applications (par. 0074-0075).

Regarding dependent claim 18, Wang teaches that modifying of the particular editing controls of the input structured document to produce the modified structured document comprises: creating new editing controls in the modified structured document providing that the new editing controls are lacking in the input structured document and providing that the new editing controls are required in the particular version of the processing functionality (par. 0056-0060; 0080-0083).

Regarding dependent claim 19, Wang teaches that modifying of the particular editing controls of the input structured document to produce the modified structured document comprises: omitting from the modified structured document existing editing controls in the input structured document that are not required in the particular version of the processing functionality (par. 0056-0060; 0080-0083).

Regarding independent claim 20, Wang teaches a method for generating an upgrade module for upgrading documents for processing by processing functionality, since Wang teaches a set of content materials, and a graphical web page editor to generate transform rules for display of content on specific devices (par. 0008-0017). Wang teaches determining whether a particular version of the processing functionality has been created that warrants generation of the upgrade module; since Wang teaches the selection and application of a template to a document for transformation (par. 0073-0074). Wang teaches generating the upgrade module if the creation of the particular version warrants the generation of the upgrade module, wherein the upgrade module is configured to modify an input structured document having particular page elements to create an updated document which conforms to a set of expected page elements associated with the particular version of the processing functionality (par. 0054-0060). Wang teaches that pages and their XSLT upgrade templates and transformation rules can be edited, modified, stored, and then further customized using the editor (par. 0069-0072). Wang teaches a web page editor that generates XSLT transform rules, assigns IDs to each web page element, matches the rules to the page elements, and modifies the page elements, using XSLT templates, so that the modified web page elements match the set of expected elements in the template (par. 0057-0076).

While Wang teaches modifying and matching page elements based on version of processing functionality, Wang strongly suggests but does not explicitly teach *editing controls with the particular version of the processing functionality* because Wang teaches a web page editor that generates XSLT transform rules, to modify page

elements, but Wang does not specify that the page elements are editing controls. However, Santos teaches a system for dynamically generating rules for XML transformations, as well as customized rules, and Santos teaches inputting a structured document having particular editing controls associated therewith into a particular version of the processing functionality, since Santos teaches generating XSL rules to transform and modify editing controls of an input document (col. 2, l. 21-50; Fig. 4, 5, 6).

Both Wang and Santos are analogous art since both are directed toward modifying a structured document using XML, rules, and XSLT transformations. It would have been obvious to one of ordinary skill in the art at the time of the invention to have applied the method of overriding XSL rules disclosed by Santos to the graphical web page editor and XSLT files disclosed by Wang, because both Wang and Santos disclose interfaces to allow a user to easily manipulate XSLT rules, and the method of overriding default rules with dynamically generated rules disclosed by Santos would have ensured that the list of XSLT rules would remain updated with the most recent rules specified by the user.

Regarding dependent claim 21, Wang teaches that the upgrade module is formed using the extensible stylesheet language (XSL) (par. 0057-0076).

Regarding dependent claim 22, Wang teaches that the updated upgrade module is configured to create new editing controls in the input structured document such that the updated document conforms to the set of expected editing controls associated with the particular version of the processing functionality (par. 0069-0072),

since Wang teaches that pages and their XSLT upgrade templates and transformation rules can be edited, modified, stored, and then further customized using the editor.

Regarding dependent claim 23, Wang teaches that the upgrade module is configured to omit editing controls in the input structured document from updated document such that the updated document conforms to the set of expected editing controls associated with the particular version of the processing functionality (par. 0069-0072), since Wang teaches that pages and XSLT upgrade templates and transformation rules can be edited, modified, stored, and then further customized using the editor.

Regarding independent claim 24, Wang teaches an apparatus for processing documents, comprising: an upgrade module configured to modify an input structured document having particular features associated therewith so that the input structured document conforms to a set of expected page elements associated with a particular version of the apparatus, to thereby produce a modified structured document; and a transformation module configured to transform the modified structured document into another document suitable for presentation (par. 0054-0060). Wang teaches that pages and their XSLT upgrade templates and transformation rules can be edited, modified, stored, and then further customized using the editor (par. 0069-0072). Wang teaches a web page editor that generates XSLT transform rules, assigns IDs to each web page element, matches the rules to the page elements, and modifies the page elements, using XSLT templates, so that the modified web page elements match the set of expected elements in the template (par. 0057-0076).

While Wang teaches modifying and matching page elements based on version of processing functionality, Wang strongly suggests but does not explicitly teach *a set of expected editing controls associated with a particular version of the apparatus* because Wang teaches a web page editor that generates XSLT transform rules, to modify page elements, but Wang does not specify that the page elements are editing controls. However, Santos teaches a system for dynamically generating rules for XML transformations, as well as customized rules, and Santos teaches inputting a structured document having particular editing controls associated therewith into a particular version of the processing functionality, since Santos teaches generating XSL rules to transform and modify editing controls of an input document (col. 2, l. 21-50; Fig. 4, 5, 6).

Both Wang and Santos are analogous art since both are directed toward modifying a structured document using XML, rules, and XSLT transformations. It would have been obvious to one of ordinary skill in the art at the time of the invention to have applied the method of overriding XSL rules disclosed by Santos to the graphical web page editor and XSLT files disclosed by Wang, because both Wang and Santos disclose interfaces to allow a user to easily manipulate XSLT rules, and the method of overriding default rules with dynamically generated rules disclosed by Santos would have ensured that the list of XSLT rules would remain updated with the most recent rules specified by the user.

Regarding independent claim 25, claim 25 is directed to the apparatus used to implement the methods as claimed in independent claim 20, and is rejected along the same rationale.

Regarding independent claim 26, claim 26 is directed toward the computer readable medium having stored thereon an information structure to be implemented by the apparatus as claimed in independent claim 24, and is rejected along the same rationale.

Allowable Subject Matter

10. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amelia Rutledge whose telephone number is 571-272-7508. The examiner can normally be reached on Monday - Friday 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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